

Remarks/Arguments

A. Status of the Claims

Claims 1-38 were pending when the Office Action was mailed February 23, 2007.

Claims 15-16, 22, 30, and 37 have been revised. No claims have been added.

Claims 1-38 remain pending.

B. Information Disclosure Statement

The Examiner indicates that foreign documents JP H2-96371 and JP H3-294802 are the same reference. Applicant confirms that these documents are the same reference.

The Examiner indicates that the references cited in the Search Report for PCT/EP20005/002262 were considered but will not be listed on any patent resulting from this application because the references were not provided on a separate list. Applicant is submitting a Supplemental Information Disclosure Statement that lists these references to ensure that they are listed on any patent resulting from this application.

C. The Objection of Claim 22 Is Overcome

Claim 22 is objected because of a typographical error. This claim has been amended to correct the typographical error. Applicant requests that the objection be withdrawn.

D. The Indefiniteness Rejection Is Overcome

Claims 31-35 are rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The Examiner contends that the phrase “the microstructure” in claim 31 lacks antecedent basis. Claim 31 has been revised to address the antecedent basis issue. Applicant requests that this rejection be withdrawn.

E. The Obviousness Rejections Are Overcome

1. Summary of the Rejections

The Examiner presents two obviousness rejections under 35 U.S.C. § 103(a). In the first, claims 1-21 are rejected as being obvious over Degand in view of Goepfert. The second rejection concerns claims 22-30 and 36-38 as allegedly being obvious over Degand in view of Goepfert and in further view of Hayashi.

According to the Examiner, Degand discloses all of the elements of Applicant's claimed ophthalmic lens except the claimed "latex layer having an outer main face provided with parallel microgrooves, and a polarizing dye material filling at least partially the said microgrooves." *See* Office Action at page 4. In an effort to supplement the deficiencies of this reference, the Examiner cites to Goepfert and alleges that it discloses this missing element at column 2, lines 16-17, 25-32, 36-40, and 59-68 of its disclosure. *Id.* at pages 4-5. The Examiner concludes that it would have been obvious to modify the Degand latex layer to have parallel microgrooves in view of the teachings in Goepfert. Hayashi *et al.* is said to disclose "preparing the face of a photosensitive resin layer opposite to the substrate by forming parallel microgrooves on the said face of the photosensitive resin layer...." Office Action at page 11.

Applicant disagrees with these rejections. The following sections provide detailed arguments confirming that claims 1-30 and 36-38 are not rendered obvious over the cited references.

2. **Claims 1-21 Are Patentable Over Degand in view of Goepfert**

i. *Every element of Applicant's claimed invention is not disclosed by the references*

Applicant's claimed invention is directed to an ophthalmic lens that includes a composite film deposited on the front surface of an organic glass substrate, where the film includes "a latex layer having an outer main face provided with parallel microgrooves." *See* claim 1.

By comparison, neither Degand nor Goepfert disclose Applicant's claimed latex film that includes parallel microgrooves. In fact, the examiner concedes that Degand fails to disclose such a film. *See* Office Action at page 4. As for Goepfert, although this reference discloses parallel microgrooves, the grooves are made on glass substrate and not on any composite film:

The invention is also concerned with a process for obtaining such a laminated, transparent, polarizing glass characterized in that it comprises the following steps:
(a) forming parallel microgrooves on a surface of an inorganic or organic glass support which is to receive the polarizing coating, these grooves frequently being made with the aid of a very gentle abrasion of the afore-said support;

Goepfert at col. 2, lines 25-32 (underlines added); *see also id.* at Abstract. Therefore the combination of Degand and Goepfert fails to disclose or suggest every element of Applicant's claimed invention (e.g., a latex layer having parallel microgrooves). Rather, the combination of these references would result in a glass substrate that has parallel microgrooves on its front surface (see Goepfert), where the front surface is then laminated with "an impact-impact resistant primer layer based on a polyurethane latex" (see Degand).

Because the combination of Degand and Goepfert fails to disclose every element of Applicant's claimed invention, a *prima facie* case of obviousness has not been established. *See* MPEP § 2143.03 ("To establish a *prima facie* case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

ii. *There is no apparent reason to modify Degand to include Applicant's claimed latex layer comprising parallel microgrooves*

There is no apparent suggestion to modify Degand's latex to include parallel microgrooves for several reasons. Degand's teachings appear to be deficient with respect to polarization techniques. As for Goepfert, it suggests forming parallel grooves on the glass substrate surface itself and not on any latex layer. *See above*. In fact, Goepfert actually teaches away from using polarization films that are deposited on glass substrates (much less modifying such films to include parallel microgrooves) by explaining that such techniques "come up against a number of difficulties":

For all that, attempts to obtain glass lenses have consisted in associating an organic polarizing film of the polyvinyl alcohol type with one or two ("sandwich") elements of glass. These attempts have come up against a number of difficulties such as:

the complexity of bonding the polarizing film to an optical substrate without deforming the direction of polarization, as indicated in French Patent No. 76.18891, filed June 22, 1976 by American Optical Corporation;

the weight of the assemblies thus obtained are not compatible with, for example, the conventional lenses utilized in spectacles (10-25 grams); and

the extremely high cost of such products which is a result of their complexity.

For these reasons, these products are not much used for applications of the "general public" type such as spectacle making.

Goepfert at col. 1, lines 27-44. This reference explains that its goal is to overcome these deficiencies by incorporating the microgrooves into the surface of the glass substrate. *Id.* at col. 2, lines 8-11 and 28-32. Stated another way, there is no apparent reason to modify Degand's latex to include the parallel microgrooves disclosed in Goepfert when considering the teachings of these references. This is an indication of non-obviousness. *See KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S. April 30, 2007).

iii. *The combined teachings of Degand and Goepfert teach away from Applicant's claimed invention*

The combined teachings of Degand and Goepfert teach away from Applicant's claimed "latex layer having an outer main face provided with parallel microgrooves." *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.").

For instance, a person of ordinary skill in the art, upon reading the cited references, would be led to "forming parallel microgrooves on a surface of an inorganic or organic glass support...these grooves frequently being made with the aid of a very gentle abrasion of the afore said support." Goepfert at col. 2, lines 28-32. This is divergent from the path taken by Applicant which uses a latex layer that includes the parallel microgrooves. Goepfert even discourages using polarization films that are deposited on the glass substrate. *Id.* at col. 1, lines 27-31. These facts lead to one conclusion—the cited references do not render Applicant's claimed invention obvious. *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) ("[A]n applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect.").

The rejection of claims 1-21 under 35 U.S.C. § 103(a) as being rendered obvious over Degand in view of Goepfert should be withdrawn for at least the reasons stated above.

3. **Claims 22-30 and 36-38 Are Patentable Over Degand in view of Goepfert and in further view of Hayashi**

Claims 22-30 and 36-38 are not rendered obvious over Degand in view of Goepfert and in further view of Hayashi for at least three reasons. First, the arguments made above equally apply to this rejection given the fact that two of the three references used are also used in the above rejection. Therefore, Applicant incorporates the arguments made above into this section by reference. This is sufficient to overcome the obviousness rejection. *See* MPEP § 2143.03.

Second, there is no apparent motivation to combine the teachings of Goepfert with Hayashi. As explained above, Goepfert concerns “forming parallel microgrooves on a surface of a glass support...with the aid of a very gentle abrasion of the aforesaid support.” Goepfert at col. 2, lines 28-32. Goepfert also discourages using organic polarization films which can be deposited on the substrate. *Id.* at col. 1, lines 27-44. By comparison, Hayashi appears to concern a method for forming a polarizing film for use with liquid crystal display (“LCD”) components. Hayashi at page 1, lines 20-25. The film apparently has “numerous fine grooves [that] are formed in the surface of this layer.” *Id.* at lines 9-16. The film is “applied to liquid crystal display components....” *Id.* at lines 24-25. When the teachings of Goepfert and Hayashi are compared, it is clear that these references teach away from one another in at least two respects:

- (i) Goepfert concerns forming parallel microgrooves on the surface of the substrate, whereas Hayashi adds “numerous fine grooves” to a film that is deposited on the substrate.
- (ii) Goepfert discourages using polarization films that are deposited on the substrate surface whereas Hayashi’s invention is directed to polarizing films that are “applied to liquid crystal display components....”

Because these references teach away from one another, they cannot be combined to support the present obviousness rejection. MPEP § 2145[X](D)(2) (“It is improper to combine references where the references teach away from their combination.”).

Third, it is improper to use Hayashi to support the present obviousness rejection because it is non-analogous art. *See In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992) (“In order to rely on a reference as a basis for [an obviousness] rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem, with which the inventor was concerned.”). Hayashi is not within Applicant’s claimed field of endeavor (e.g., preparing ophthalmic lenses as claimed in claim 22), as it relates to LCD components. Hayashi is also not reasonably pertinent to the particular problem with which the Applicant was concerned. Applicant’s specification explains a non-limiting problem associated with the solubility of polarizing materials (as well as their mechanical strength) with which the Applicant was concerned with:

It is known that the manufacture of polarizing lenses raises various problems related to the solubility of the polarizing materials (generally polarizing particles) in the surrounding environments, as well as their very low mechanical strength.

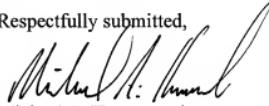
Specification at page 1, lines 11-14. By comparison, the collaborators in Hayashi were concerned with problems associated with foreign material being incorporated into the LCD display by using polarization plates. Hayashi at page 3, lines 16-26 (“Therefore, the object of the present invention is to provide a method for forming polarizing films for LCDs with which it is not necessary to stick on a separate polarization plate.”). It is clear that Hayashi is non-analogous art, and it is therefore improperly used to support the current obviousness rejection.

The rejection of claims 22-30 and 36-38 under 35 U.S.C. § 103(a) as being rendered obvious over Degand in view of Goepfert and in further view of Hayashi should be withdrawn for at least the reasons stated above.

F. Conclusion

The present claims are in a condition for allowance, and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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